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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,667	04/07/2000	David R. Thomas	TI-27109	9856

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EXAMINER

CUFF, MICHAEL A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,667

Applicant(s)

Thomas et al.

Examiner

Michael Cuff

Art Unit

3627

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 8, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-46 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

Art Unit: 3627

DETAILED ACTION

Amendment

Applicant's amendment, filed 1/8/03, has been received and entered. Claim 8 has been canceled. Claims 1, 2, 7, 9, 10, 16-25, 27, 28, 30, 34, 35, 39, 42, 43, and 46 have been amended.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 and 9-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kaplan in view of Shaw et al.

Kaplan shows all of the limitations of the claims except for specifying the degraded signal for the samples and some details as to how the digital signal is processed.

Kaplan shows, figure 2, a network and method for preview and sale (includes authorization requests and replies) of music products. Kiosk unit 10 acts as a dialogue unit, digital processor, with a product reader including a signal processing unit. A range of audio/video products are available. Database 60 maintains customer files and demand data.

Art Unit: 3627

Shaw et al. teaches, figure 1, a system and method for producing a quantized signal where the broadcaster has the control to select the appropriate quality level that he or she wants in order to conserve bandwidth (column 3, lines 34-36)

Based on the teaching of Shaw et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Kaplan system to select the appropriate quality level (degraded level) in order to conserve bandwidth.

The examiner takes official notice the digital signal processes claimed are old and well known and are commonly used in order to manipulate digital products. (For example, the examiner found 2,649 direct hits on “discrete Fourier transforms”, 3,195 hits on “frequency modulator”, and 26 hits on “frequency band rejections”

Based on the discussion above, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Kaplan system to use standard digital processes in order to manipulate digital products.

Response to Arguments

3. Applicant's arguments filed 1/8/03 have been fully considered but they are not persuasive.

Applicant asserts that claims 1 and 43 recite “a processing core operable to apply a defined ...” which is not shown by the prior art. Applicant further asserts that claim 42 recites “means for processing the digital ...” which is not shown by the prior art. The examiner does not concur. Kaplan shows a digital processor (a processing core, means for processing) which meets

Art Unit: 3627

the metes and bounds of the broadly recited apparatus claims. Note that the processing core is only operable to accomplish certain tasks. The prior art need not perform the tasks, but the prior art must be capable of performing the certain tasks. The examiner suggests that applicant review the actual apparatus disclosed in figures 1 and 2, and further reviews the use and patentable weight of functional language in an apparatus claim.

For the purposes of 35 USC 112, 6th paragraph, the examiner is considering the “means for processing ...” to be the merchant server 130. The “means for outputting” is merely a network connection.

Applicant asserts, for claim 35, that the addition of the limitation “having a degradation in perceived quality corresponding to said defined level of content degradation” is not shown. The examiner does not concur. The examiner believes that this merely states an inherent trait that a degraded signal will have degraded quality. (Most of page 12 of applicant’s response argues the same as above for claims 39, 46, 3, 36 and 40.)

Applicant asserts that their goal for degrading a signal is different than Shaw’s teaching. This is not relevant. There can be more than one obvious reason to degrade a signal. Applicant has not provided a method limitation which is not shown or taught. For example, applicant argues that its degradation processes “degrade the perceived quality of the signal without reducing its bandwidth”. But this is not claimed.

Art Unit: 3627

Applicant asserts that the prior art does not show an authorization response. The examiner does not concur. Authorization requests/responses, as broadly claimed, are inherent characteristics of a network sale which is shown by Kaplan.

Applicant asserts that neither Kaplan nor Shaw et al. show the subject matter of claims 6, 7, 10, 11, 14-28 and 30-34. Applicant further asserts that examiner's use of official notice regarding the use of standard digital processes is not relevant. The examiner does not concur. The references of Kaplan and Shaw et al. teach the basic premise of selling digital products over a network and sending samples at a degraded quality level. The examiner's official notice regarding standard digital processes "fills in the gaps" of the multitude of well known digital manipulation processes. Further, applicant has not properly traversed the official notice per "*Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice*" from Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy, February 21, 2002; and MPEP 707.06 authorizing citations to Commissioner's memorandums. The memorandum states, "To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate."

The above argument applies to claim 45, too.

Art Unit: 3627


Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication should be directed to Michael Cuff at telephone number (703) 308-0610.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113. The fax phone number for this Group is (703) 872-9326. (After Final special fax number (703) 872-9327) The customer service number is (703) 872-9325.


Michael Cuff
March 20, 2003